

**Remarks**

Claims 1-32 and 72-103 are pending in the application. Claim 103 has been amended. No new matter has been added by virtue of this amendment. Reconsideration of the application as amended is requested.

**Interview**

Applicant would like to thank the Examiner for the very helpful interview on June 17, 2003, during which the rejections of claims 1, 102, and 103 were discussed.

**Claim Rejections--35 U.S.C. § 112, First Paragraph**

The Examiner rejects claim 1-32 and 72-101 under 35 U.S.C. § 112, first paragraph, as "containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention." The Examiner further states that "the recitation of 'said dicing step disconnects mechanical connection between adjacent coils' is new matter."

The rejected recitation has been removed and replaced with:

- c) dicing completely through said coil to provide a plurality of short coils, wherein each said short coil has at least one said opening in said insulation.

Applicant would respectfully ask the Examiner to consider that the specification, as originally filed states on page 8, line 11.

Once windows 30 have been formed along coil 28, coil 28 is diced into short coils 28', along cutting plane 36, as shown in FIG. 2a.

The next paragraph states:

After dicing, short coil 28' is mounted on and connected to substrate 34 by soldering exposed conductor 22' in windows 30 of short coil 28' to pads 32 of substrate 34 to form solder joints 38, as shown in FIGS. 2a, 2b.

Fig. 2a shows short coil 28' mounted to substrate 34. It is seen that short coil 28'

is completely disconnected from remaining portions of long coil 28 shown in FIG. 1a. Thus, applicant had possession of the idea of "dicing completely through said coil" at the time the application was filed. Thus, the rejection of claims 1-32 and 72-101 under 35 U.S.C. § 112, first paragraph has been traversed.

#### **Claim Rejections--35 U.S.C. § 112, Second Paragraph**

The Examiner rejects claim 1-32 and 72-101 under 35 U.S.C. § 112, second paragraph, as being indefinite since "in claim 1, it is unclear from the disclosure what is meant by the phrase, or what is even encompassed by the phrase of a 'mechanical connection.'" The Examiner asks, "how is the electronic device mechanically connected?"

The rejected phrase 'mechanical connection' having been eliminated from the claims, the rejection of claims 1-32 and 72-101 under 35 U.S.C. § 112, second paragraph has been traversed.

#### **Claim Rejections--35 U.S.C. § 102**

The Examiner rejects claim 103 under 35 U.S.C. § 102 as being anticipated by Person et al. However, applicant would respectfully ask the Examiner to consider that claim 103, as amended states: "providing a coil of conductor, an insulation, and a tube, said coil of conductor having a coil outer surface, said insulation on said coil outer surface, wherein said tube has a tube outer surface and **wherein said coil of conductor and said insulation are on said tube outer surface.**" In Person, the "tube" identified by the Examiner as termination caps 12 and 14, is inserted on the coil of conductor. There is no teaching or suggestion of providing a coil of conductor and insulation on the tube outer surface.

#### **Claim Rejections--35 U.S.C. § 103**

The Examiner rejects claim 102 under 35 U.S.C. § 103 as being unpatentable over Jones in view of Person. al. However, applicant would respectfully ask the Examiner to consider that claim 102, as amended states:

- b) **forming openings in portions of said insulation on said coil outer surface and exposing conductor in said openings for external contacts;**

In Person, conductor 32 and conductor 64 (FIG. 1 and 2) extend to end surfaces of monolithic inductor 10. There is no teaching or suggestion of "forming openings in portions of said insulation on said coil outer surface and exposing conductor in said openings for external contacts." Furthermore, there is no teaching or suggestion of forming insulation covering conductor 32 or conductor 64, so there can be and is no teaching of forming openings in portions of that insulation on the coil outer surface and exposing conductor of said coil for contacts. Thus, the rejection of claim 102 under 35 U.S.C. § 103 as being unpatentable over Jones in view of Person has been traversed.

Applicant would respectfully ask the examiner to consider that claim 1, as amended has a similar limit as claim 102, as amended, and therefore claim 1, and claims dependent thereon, ought also to be allowable over Jones and Person.

### Conclusion

Applicant's attorney has reviewed the prior art made of record and not relied upon and believes that this reference is no more relevant than those relied upon.

It is believed that all the claims are in condition for allowance. Therefore, applicant respectfully requests favorable reconsideration. If there are any questions please call applicant's attorney at 802 864-1575.

Respectfully submitted,

For: Arms et al.

By: James M. Leas  
Registration Number 34,372  
Tel: (802) 864-1575

James M. Leas  
37 Butler Drive  
S. Burlington, Vermont 05403